Remarks

Claims 1-13, 16-19 and 21-28 are pending in this application.   Solely in an effort to expedite prosecution, claims 21 and 24 are currently amended.   Claims 27 and 28 are newly added.   No claims are cancelled by this amendment, and no new subject matter has been added.   In view of the foregoing amendment and the following remarks, allowance of all the claims pending in the application is requested.

Rejection Under 35 U.S.C. § 103

Claims 1-3, 5, 7-10, 12, 16, 17, 19, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. (US 6,401,113) in view of Foladare et al. (US 5,905,777).   Applicant traverses this rejection on the following basis.

Claims 1-3, 5, 7-10, and 12

Independent claim 1 recites, among other things, the feature of a database that stores at least one electronic message addressed to the first terminal device and at least one scripting agent that accesses the database, retrieves the electronic message addressed to the first terminal device stored on the database, and processes the electronic message for transmission to the second terminal device.   Independent claim 8 includes similar subject matter, among other things.

In an exemplary embodiment, a server operating in a computer network system may receive an email message addressed to a receiving client (see the Specification at page 5, lines 14-18).   The email message received by the server may be stored in an email database (see the Specification at page 5, lines 15-19).   After the email message is stored in the email database, a scripting agent may access the email message and process the email message based on predetermined instructions (see the Specification at page 5, lines 14, 15, and 19-21).   The scripting agent may process the email message based on a user profile or a receiving client profile such that the

processed email message may be received on a wireless client device, including a pager device (see the Specification at page 5, lines 19-24).

The Examiner admits that Lazaridis is deficient at least for failing to teach or suggest a database that stores at least one electronic message addressed to the first terminal device and at least one scripting agent that accesses the database, retrieves the electronic message addressed to the first terminal device stored on the database, and processes the electronic message for transmission to the second terminal device (see the Office Action at page 2, lines 31-37). The Examiner attempts to cure this deficiency of Lazaridis by applying Foladare. The Examiner alleges that Foladare teaches "a server for setting an email preference for delivery to a pager when a recipient is away from his office computer and ... access[ing] the recipient record for [a] type of delivery to be forwarded to the pager," at column 5, lines 15-37 (see the Office Action at page 2 line 37-page 3, line 3). Even if this characterization of the cited passage of Foladare was accurate, which it is not, it still would not cure the deficiency of Lazaridis. Similar to Lazaridis, the portion of Foladare relied upon by the Examiner fails to teach or suggest, among other things, a **database that stores at least one electronic message** addressed to the first terminal device and at least one scripting agent that accesses the database, retrieves the electronic message addressed to the first terminal device stored on the database, and processes the electronic message for transmission to the second terminal device. Therefore, the rejection of independent claims 1 and 8 based upon the combination of Lazaridis and Foladare is improper because the applied references, both alone and in combination, fail to teach or suggest all of the features of the claimed invention.

Additionally, the combination of Lazaridis and Foladare is improper at least for failing to include a proper motivation for combination. The Examiner asserts that Foladare would have provided motivation for combining Foladare with Lazaridis to enable a computer to decide how an electronic message should be forwarded to a mobile computer, or pager (see the Office Action at page 3, lines 11-15). However, this is an inaccurate representation of the disclosure of Foladare. For example, the

passage of Foladare cited by the Examiner appears to disclose a method for forwarding an **email alert**, not an actual email message, to a pager device (see Foladare at col. 5, lines 15-37). An email alert is described as including a sender ID, a title, and an email message ID (see Foladare at col. 4, lines 37-39). Upon receiving the email alert on the pager, a recipient selects, via the pager, a destination device (other than the pager) for the actual email message associated with the email alert to be forwarded to for further access by the recipient (see Foladare at col. 5, lines 48-53). Since Lazaridis apparently describes a system for automatically and continuously forwarding email messages addressed to a user to a mobile device associated with the user, one of ordinary skill in the art would not have been motivated to combine the teachings of Lazaridis with the system of sending **email alerts** to a pager device taught in Foladare.

Further, the combination of Lazaridis and Foladare is improper for lacking proper motivation to combine because the disclosures of the proposed combination are drawn to fundamentally different data communications system. The disclosure of Lazaridis appears to be drawn to a "push" type of system where actual email messages are automatically forwarded to a specific mobile device (see Lazaridis at the Abstract). In contrast, the disclosure of Foladare apparently describes a "pull" type of system that involves receiving an email alert on a pager and selecting, via a pager, a forwarding destination (other than the pager) for an email message associated with the email alert (see Foladare at the Abstract). In light of the fundamental differences between the disclosed data communications systems, one of ordinary skill in the art would not have been motivated to combine Lazaridis with Foladare.

Accordingly, withdrawal of the rejections of claims 1 and 8 are requested. Claims 2, 3, 5, 7, 9, 10, and 12 depend from and add additional features to independent claims 1 and 8. Therefore, claims 2, 3, 5, 7, 9, 10, and 12 are allowable, by virtue of their dependency, as well as for the features that they add to the independent claims.

Claims 16, 17, 19, 21, and 24

Independent claim 21 recites, among other things, a scripting agent that processes the electronic message addressed to the first terminal device for transmission to the second terminal device by creating a summary of the electronic message addressed to the first terminal device if the size of the electronic message exceeds the threshold size. Independent claim 24 includes similar subject matter, among other things.

In an exemplary embodiment, a server operating in a computer network system may receive and email message addressed to a receiving client (see the Specification at page 5, lines 14-18). A scripting agent located on the server may access the email message and process the email message for transmission to a wireless client device (see the Specification at page 5, lines 19-24). The receiving client and the wireless client device may both be associated with a common user. The scripting agent may process the email message by composing a summary of the complete email message before the summarized email message is forwarded to the wireless client device (see the Specification at page 10, lines 11-13). The scripting agent may summarize the email message based at least in part on a profile available to the scripting agent (see the Specification at page 10, lines 14 and 15). The scripting agent may summarize the email message based on predefined terms, based on the number of times words appear in the email message, or based on user defined rules (see the Specification at page 10, lines 15-18). The email message may be summarized based on a determination that a size of the email message has exceeded a threshold size (see the Specification at page 11, lines 8-10).

The Examiner admits that Lazaridis does not teach or suggest creating a summary of the electronic message addressed to the first terminal device (see the Office Action at page 4, lines 31-34). The Examiner alleges that Foladare teaches "an email paging system wherein a summary of email messages are sent to a recipient," in the Abstract of the disclosure (see the Office Action at page 4, lines 34-37). Even if

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the Examiner's allegation regarding the disclosure of Foladare is accepted arguendo, Foladare does not teach or suggest a scripting agent that processes the electronic message addressed to the first terminal device for transmission to the second terminal device by creating a summary of the electronic message addressed to the first terminal device if the size of the electronic message **exceeds the threshold size**. Therefore, the rejection of claims 21 and 24 based on Lazaridis and Foldare must be withdrawn because the cited references, both alone and in combination, fail to teach or suggest all of the features of the claimed invention.

Additionally, the combination of Lazaridis and Foladare is improper at least for failing to include a proper motivation for combination. The Examiner asserts that one of ordinary skill in the art would have been motivated to combine Foladare with Lazaridis "to provide the mobile computer a brief summary of the messages that was sent to the desktop computer when the user is away" (see the Office Action at page 4, lines 42-45). This motivation is improper because it merely recites the features that would be added to Lazaridis, but does not include a **suggestion of the desirability** of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, the combination of Lazaridis and Foladare is improper for lacking proper motivation to combine because the disclosures of the proposed combination are drawn to fundamentally different data communications system. The disclosure of Lazaridis appears to be drawn to a "push" type of system where actual email messages are automatically forwarded to a specific mobile device (see Lazaridis at the Abstract). In contrast, the disclosure of Foladare apparently describes a "pull" type of system that involves receiving an email alert on a pager and selecting, via a pager, a forwarding destination (other than the pager) for an email message associated with the email alert (see Foladare at the Abstract). In light of the fundamental differences between the disclosed data communications systems, one of ordinary skill in the art would not have been motivated to combine Lazaridis with Foladare.

Accordingly, withdrawal of the rejections of claims 21 and 24 are requested. Claims 16, 17, and 19 depend from and add additional features to independent claims 21 and 24. Therefore, claims 16, 17, and 19 are allowable, by virtue of their dependency, as well as for the features that they add to the independent claims.

Claims 4, 6, 11, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. (US 6,401,113) in view of Foladare et al. (US 5,905,777) and in further view of Woltz et al. (US 6,216,165). Applicant traverses this rejection on the following basis.

Claims 4, 6, 11, and 13

The Examiner acknowledges that Lazaridis and Foladare do not disclose transmitting the electronic message to the wireless terminal device after the passage of a predetermined amount of time during which the electronic message has not been opened at the first terminal, and relies on Woltz to teach this feature (see the Office Action at page 5, line 33-page 6, line 7) . Woltz appears to disclose generating different email message formats to enable compatibility with various pager types (see col. 4, lines 16-29). The rejection based on the combination of Lazaridis, Foladare, and Woltz is improper for failing to include a proper motivation to combine the references. Further, the cited references, both alone and in combination, fail to disclose a database that stores at least one electronic message addressed to the first terminal device and at least one scripting agent that accesses the database, retrieves the electronic message addressed to the first terminal device stored on the database, and processes the electronic message for transmission to the second terminal device, among other things. Even if the Examiner's allegation with respect to Woltz is accepted, claims 4, 6, 11, and 13 depend from claims 1 and 8, and are therefore allowable over the cited prior art for the reasons addressed above, as well as for the features they add to the independent claims.

Claim 18

The Examiner acknowledges that Lazaridis and Foladare do not disclose transmitting the electronic message to the wireless terminal device after the passage of a predetermined amount of time during which the electronic message has not been opened at the first terminal, and relies on Woltz to teach this feature (see the Office Action at page 5, line 33-page 6, line 7) . Woltz appears to disclose generating different email message formats to enable compatibility with various pager types (see col. 4, lines 16-29). The rejection based on the combination of Lazaridis, Foladare, and Woltz is improper for failing to include a proper motivation to combine the references. Further, the cited references, both alone and in combination, fail to disclose a scripting agent that processes the electronic message addressed to the first terminal device for transmission to the second terminal device by creating a summary of the electronic message addressed to the first terminal device if the size of the electronic message exceeds the threshold size, among other things. Even if the Examiner's allegation with respect to Woltz is accepted, claim 18 depends from claims 21, and is therefore allowable over the cited prior art for the reasons addressed above, as well as for the feature it adds to the independent claim.

Claims 22, 23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. (US 6,401,113) in view of Foladare et al. (US 5,905,777) and in further view of Byers et al. (US 6,732,273). Applicant traverses this rejection on the following basis.

The Examiner acknowledges that Lazaridis and Foladare do not disclose a summary of the electronic message addressed to the first terminal device based on a user profile and a number of times words appear in the electronic message, and relies on Byers to teach this feature (see the Office Action at page 7, lines 1-9) . Byers appears to disclose a system that assigns a message characterization code to an electronic mail message that enables a router as well as the destination message

server to more efficiently process the electronic mail message (see col. 1, lines 8-13). The rejection based on the combination of Lazaridis, Foladare, and Byers is improper for failing to include a proper motivation to combine the references. Further, the cited references, both alone and in combination, fail to disclose a scripting agent that processes the electronic message addressed to the first terminal device for transmission to the second terminal device by creating a summary of the electronic message addressed to the first terminal device if the size of the electronic message exceeds the threshold size, among other things. Even if the Examiner's allegation with respect to Byers is accepted, claims 22, 23, 25, and 26 depend from claims 21 and 24, and are therefore allowable over the cited prior art for the reasons addressed above, as well as for the features they add to the independent claims.

Newly Added Claims

Newly added claims 27 and 28 depend from independent claims 21 and 24 respectively. Therefore, claims 27 and 28 are allowable over the cited prior art for the reasons addressed above, as well as for the features they add to the independent claims.

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If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: December 28, 2004

Respectfully submitted,

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